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NAKAMURA

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FILING DATE

FIRST NAMED APPLICANT

ATTORNEY DOCKET NO.

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FROMMER LAWRENCE & HAUG
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NEW YORK NY 10151

DATE
EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

05/11/01

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 8 months from the mailing date of the final rejection.
b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07(f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 4/16/01. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
(b) ☒ they raise the issue of new matter. (see NOTE below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims. See attachment, #1.

NOTE:

See attachment, #s 2 and 3

4. ☐ Applicant's reply has overcome the following rejection(s):
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment, #s 4 and 5
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 6-15
Claim(s) withdrawn from consideration: _____
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

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1. The proposed new claims include 7 multiple dependent claims. When the multiple dependent claims are counted separately, the total number of proposed claims is 23. Previously filed claims 6-15 included 5 multiple dependent claims. The total number of claims is 15.

2. Proposed new claims 17-20 and 22 raise the issue of new matter. The originally filed specification does not provide an adequate written description of following:

(1) In claims 17 and 18, the limitations, an intrinsic viscosity (i.v.) "less than about 0.25 dl/g" and an "i.v. of about 0.25 dl/g" (emphasis added). Compare page 5, lines 9 and 15, of the originally filed specification, which disclose an i.v. of "less than 0.25 dl/g" and an i.v. "of 0.25 dl/g." The limitation "about 0.25 dl/g" recited in claim 17 is broader than the disclosed i.v. values in the specification.

(2) In claim 19, the limitation of "about 1 to 2.5" (emphasis added). Compare page 5, line 21, of the originally filed specification, which discloses a Mw/Mn ratio from "1 to 2.5."

(3) In claim 20, the limitation "the toner is a monodisperse state." Compare page 5, line 22, of the originally filed specification, which discloses that "[t]he Mw/Mn ratio . . . is as small as from 1 to 2.5, a nearly monodisperse state" (emphasis

added). The specification does not disclose that a toner is a monodisperse state.

(4) In claim 22, the limitation of an intrinsic viscosity (i.v.) "of about 0.25 dl/g" (emphasis added). Compare page 4, line 24, of the originally filed specification, which discloses an i.v. of "0.25 dl/g."

(5) In claim 22, the limitation of a heat distortion temperature "of about 70°C or higher" (emphasis added). Compare page 4, line 25 of the originally filed specification, which discloses a heat distortion temperature of "70°C or higher."

(6) In claim 22, the limitation of "a proportion of less than about 50% by weight" (emphasis added). Compare page 4, line 28-29 of the originally filed specification, which discloses an amount of "less than 50% by weight."

3. Proposed new claims 17, 18, and 22 raise rejections under the first and second paragraphs of 35 U.S.C. 112, with respect to the recited intrinsic viscosity and heat distortion temperature for the reasons set forth in the Final rejection, Paper No. 12, paragraphs 6 and 8, with respect to claims 8, 9, and 12.

Proposed new claim 22 raises a rejection under 35 U.S.C. 112, second paragraph, for lack of unambiguous antecedent basis. It is not clear whether the polyolefin recited in claim 22 is

that recited in claims 16, 17, or 18, or is necessarily another polyolefin.

Proposed new claim 23 raises a rejection under 35 U.S.C. 112, second paragraph, for the reasons set forth in Paper No. 12, paragraph 6, with respect to claim 13.

Proposed new claim 24 raises a rejection under 35 U.S.C. 112, second paragraph, for lack of antecedent basis. Claims 16, 17, and 18 do not recite a "polyolefin resin with at least one functional group . . . " (emphasis added), as recited in claim 24.

4. Because the amendment has not been entered, applicants' arguments with respect to said amendment are moot. The objections and rejections under 35 U.S.C. 112, first and second paragraphs, set forth in the Final rejection, Paper No. 12, paragraphs 3, 4, 6, 8, and 9, stand for the reasons of record. Furthermore, as set forth in Paper No. 12, there is no disclosure in the specification of how the intrinsic viscosity is determined. The specification does not disclose the German standard DIN 53728. In addition, there is no evidence on the present record to show that the German standard DIN53461-B described in the English-language translation provided by applicants was that referred to in the instant specification, since the instant specification does not disclose the version

(i.e., date) of the standard DIN 53461-B disclosed in the instant specification. Moreover, as set forth in the objection in Paper No. 12, paragraph 3, the experimental conditions under which the intrinsic viscosity and hard distortion temperature are essential subject matter because they are necessary to describe and enable the instant claimed subject matter. Essential subject matter cannot be incorporated by referring to a non-US patent publication; it must be fully disclosed in the specification as filed. MPEP 608.01(p)A.

5. Because the amendment has not been entered, applicants' arguments with respect to said amendment are moot. The prior art rejections over Japanese Patent 58-149060 and over Sacripante set forth in Paper No. 12, paragraphs 11 and 12, stand for the reasons set forth in the Final rejections.

Applicants' arguments with respect to the prior art rejection over Japanese Patent 2-184864 (JP'864) set forth in Paper No. 12, paragraph 13, have been addressed in the Final rejection. As stated in the rejection and in the response to applicants' arguments, JP'864's cyclopentadiene-type homopolymer and copolymer meet the limitations recited in instant claims 6 and 7. Furthermore, applicants have not demonstrated why it would have been non-obvious for a person having ordinary skill in the art to add a charge control agent to the toner exemplified by

JP'864, since JP'864 teaches that a polarity-controlling agent can be added to its toners. A polarity-controlling agent is another name for a charge control agent. See the PTO translation of JP'864, page 6, lines 21-22.

The prior art rejection over Masuda combined with Inaba and Minami set forth in Paper No. 12, paragraph 14, stands for the reasons set forth in the Final rejection. Furthermore, contrary to applicants' arguments in the amendment after Final rejection, Paper No. 14, page 15, lines 12-14, Inaba has been cited to show that the compounds disclosed as antistatic agents by Masuda are also known in the art as charge control agents, not for its disclosure of waxes. Applicants' arguments in Paper No. 14 that the present invention is not directed to waxes and Minami teaches away from the instant claimed invention are not persuasive. The instant claims do not exclude the recited polyolefins having a cyclic structure from being a wax. In fact, Masuda discloses that waxes, such as paraffin waxes, can be used as toner binder resins. Col. 25, line 25. Applicants' comments in Paper No. 14, page 15, lines 17-20, that adherence of a toner comprising a wax binder resin to a substrate is only achieved by cold pressure fixing, not by a heat roller fixing means, are merely attorney arguments. There is no evidence on the present record to support applicants' comments. Moreover, as discussed in the rejection, Minami teaches that his low molecular weight cyclic olefin

copolymers can be used as electrophotographic toners. Minami discloses that his copolymers have excellent thermal resistance in addition to excellent dielectric properties, mechanical properties, and transparency. Masuda discloses that the toner binder resin in his toners can be any well-known toner binder resin in the art, which Masuda discloses includes alicyclic hydrocarbon resins. Alicyclic hydrocarbon resins encompass the Minami's cyclic olefin copolymers. Thus, for the reasons set forth in the rejection, Masuda combined with Inaba and Minami renders obvious the instant claimed toner.